

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,684,138: PAVERCAT  
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,	)	
	)	
Petitioner,	)	
v.	)	Cancellation No. 41,776
	)	
PAVE TECH, INC.,	)	
	)	
Registrant.	)	

CATERPILLAR'S RESPONSE TO PAVE TECH'S  
MOTION TO QUASH AND FOR PROTECTIVE ORDER

I. INTRODUCTION

Pave Tech has presented no valid grounds to prevent the depositions of Glen Wroblewski and Dale Sapkowski after the Board grants Caterpillar's motion for extension of the discovery period. Pave Tech requested an order quashing<sup>1</sup> Caterpillar's depositions of Glen Wroblewski and Dale Sapkowski on the grounds that the depositions were unnecessary and untimely. Neither of these assertions, however, are true. Therefore, Caterpillar requests that the Board deny Pave Tech's motion to quash.

II. ARGUMENT

A. Caterpillar's deposition notices are necessary.

<sup>1</sup> Pave Tech also requested a motion for protective order to prevent the depositions from taking place on May 12 and 14<sup>th</sup>. This request is moot. Pave Tech filed its motion on May 11<sup>th</sup>. Because Pave Tech had made it clear that it did not intend to produce the requested witnesses pursuant to the notices of depositions, Caterpillar cancelled the depositions for those dates.

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Certificate of Mailing  
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington Virginia 22202-3514 on June 1, 2004.

Pave Tech attempts to justify its refusal to extend the discovery period by claiming that the depositions of Glenn Wroblewski and Dale Sopkowiak requested by Caterpillar were "unnecessary" and "retaliatory in nature." Pave Tech's Motion to Quash, p. 3. Both of these claims are false. First, the requested depositions were necessary. Pave Tech bases its argument that Caterpillar admitted the requested depositions were unnecessary on Caterpillar's April 28<sup>th</sup> settlement proposal letter. In that letter, Caterpillar stated that "Caterpillar believes that the [February 23 and 24<sup>th</sup>] deposition testimony established that there is a likelihood of confusion." Exhibit A, April 28 Caterpillar letter. This statement does not admit that the requested deposition testimony was unnecessary. In fact, the deposition testimony of Glenn Wroblewski and Dale Sopkowiak could be essential to Caterpillar's case. Both of these witnesses were identified as people who had direct contact via telephone and at trade shows with consumers who possibly could be confused between the Caterpillar Marks and the PAVERCAT mark. Exhibit B, Dec. of Mary Innis. This type of actual confusion evidence could be the lynch pin in Caterpillar's case and therefore cannot be deemed by Pave Tech as "unnecessary."

Moreover, Caterpillar's request for these depositions was not retaliatory. Pave Tech incorrectly claims that Caterpillar first requested these depositions after Pave Tech served its notice of depositions. This is not true. At the February 23-24 depositions – almost two months before Pave Tech served its notices of depositions - Caterpillar told opposing counsel that it intended to take the depositions of Glen Wroblewski and Dale Sopkowiak. Exhibit B, Declaration of Mary Innis. Moreover, since that time Caterpillar consistently conveyed to opposing counsel that Caterpillar intended to take these depositions if the parties did not reach a settlement of this matter in the interim. Exhibit C, April 22<sup>nd</sup> e-mail from Mary Innis. Therefore, Pave Tech has long had notice of Caterpillar's intent to take the noticed depositions

and in no way were the request for these depositions in response to Pave Tech's deposition notices.

B. Caterpillar's deposition notices were timely.

Pave Tech also argues that Caterpillar's deposition notices were not timely. As more fully set forth in Caterpillar's Motion for Protective Order and Motion for Extension of the Discovery and Testimony Periods, Pave Tech reneged on its agreement to extend the discovery period forcing Caterpillar to file a contested Motion for Extension of Discovery and the Testimony Periods. Exhibit D, Dec. of Nerissa Coyle McGinn. Based upon its telephone conference with Pave Tech, Caterpillar believed that Pave Tech had already agreed to a 30 day extension of the discovery period. Thus, Caterpillar properly noticed these depositions within the 30 day extension period. If Pave Tech had not reneged on its agreement, then Caterpillar's deposition notices would have been timely.

Pave Tech claims that it never agreed to the 30 day extension of the discovery period. To support that claim, Pave Tech attached two declarations describing attorney-client communications *to which Caterpillar was not privy*. Pave Tech's instructions to its attorney are not relevant. Whether or not Pave Tech's counsel had permission to agree to a 30 day extension of the discovery period, Pave Tech's counsel communicated to Caterpillar that it would agree to the extension and Caterpillar timely noticed the depositions accordingly. Pave Tech cannot refute the fact that it did not agree to a 30 day extension with conversations and instructions to which Caterpillar had no knowledge.

### III. CONCLUSION

Because these depositions are neither untimely nor unnecessary, Caterpillar request that the Board allow the parties to reschedule these depositions after the Board has granted Caterpillar's Motion for Extension of Time and Discovery Periods.

Dated: June 1, 2004

LOEB & LOEB LLP

By: 

Mary E. Innis

Nerissa Coyle McGinn

200 South Wacker Drive, Suite 3100

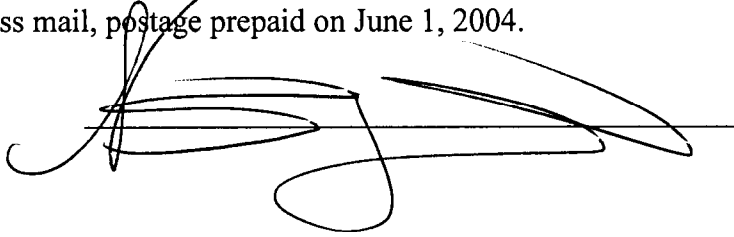
Chicago, Illinois 60606

Telephone: (312) 674-4780

Facsimile: (312) 674-4779

**CERTIFICATE OF SERVICE**

I, Nerissa Coyle McGinn, hereby certify that I caused a copy of the foregoing  
**CATERPILLAR'S RESPONSE TO PAVE TECH'S MOTION TO QUASH AND FOR  
PROTECTIVE ORDER** to Michael J. O'Loughlin, Micheal J. O'Loughlin & Associates, P.A.,  
400 South 4<sup>th</sup> Street, 1012 Grain Exchange Building, Minneapolis, Minnesota 55415 and  
Rebecca Jo Bishop, Altera Law Group LLC, 6500 City West Parkway, Suite 100, Minneapolis,  
MN 55344, via first class mail, postage prepaid on June 1, 2004.

A handwritten signature in dark ink, appearing to be "Nerissa Coyle McGinn", written over a horizontal line.

# LOEB & LOEB LLP

A LIMITED LIABILITY PARTNERSHIP  
INCLUDING PROFESSIONAL CORPORATIONS

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A

Direct Dial: 312-674-4784  
e-mail: [nmcginn@loeb.com](mailto:nmcginn@loeb.com)

April 28, 2004

## VIA FACSIMILE & U.S. MAIL

Michael J. O'Loughlin  
Michael J. O'Loughlin & Associates, P.A.  
400 South 4th Street  
1012 Grain Exchange Building  
Minneapolis, MN 55415

Rebecca Jo Bishop  
Altera Law Group  
6500 City West Parkway  
Suite 100  
Eden Prairie, MN 55322

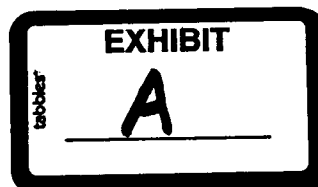
Re: Caterpillar Inc. v. Pave Tech, Inc.

Dear Michael:

After reviewing the deposition testimony of Stephen Jones and Robert Cramer, Caterpillar believes that the deposition testimony establishes that there is a likelihood of confusion between the Caterpillar Marks and Pave Tech's PAVERCAT mark. The most damning of the evidence against Pave Tech is the fact that one of Pave Tech's 30(b)(6) witnesses admitted that there is a possibility of confusion between the two marks. In his deposition, Bob Cramer admitted that he believed there was a possibility that attendees at trade shows might mistakenly believe that the PAVERCAT product was somehow associated with Caterpillar. Cramer, p. 34-35.

In addition to this admission, Caterpillar also believes the deposition testimony demonstrates a likelihood of confusion between the PAVERCAT and the Caterpillar Marks because the marks, the products sold in connection with the marks, and the markets in which the products are sold are confusingly similar. First, the addition of the descriptor "paver" does not sufficiently distinguish the PAVERCAT mark from the Caterpillar Marks. The only difference between the CAT and PAVERCAT marks is the word "paver" which Pave Tech has admitted is generic for the type of brick used in segmental paving. Jones, p. 11, 16-17; Cramer, p. 47. The Board repeatedly has ruled that the combination of a descriptive or generic term such as "paver" with a famous mark such as the CAT mark does not adequately distinguish the challenged mark from the CAT mark. *Caterpillar Inc. v. Gehl Company*, 177 U.S.P.Q. 343 (TTAB 1973) (holding that Caterpillar's mark CAT and respondent's mark HYDRACAT were

LOS ANGELES  
NEW YORK  
CHICAGO  
NASHVILLE



Michael J. O'Loughlin  
Rebecca Jo Bishop  
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confusingly similar); *Caterpillar v. Electric Carrier Corp.*, 201 U.S.P.Q. 778 (T.T.A.B. 1978) (sustaining Caterpillar's opposition against applicant's mark ELECTRICAT).

Moreover, Pave Tech has a family of marks which combine two generic terms such as the following:

1. PAVEREXTRACTOR – a tool used to extract pavers
2. PAVERCART – a cart used to transport pavers
3. PAVERADJUSTER – a tool used to adjust pavers.

Similar to Pave Tech's other marks, Caterpillar believes that the PAVERCAT mark is a combination of two terms being used descriptively. As admitted by Pave Tech, the term "paver" is descriptive of the type of bricks used in the segmental paving industry. Moreover, both Stephen Jones and Bob Cramer admitted that CAT is a well-known or famous brand name for heavy equipment. Cramer, p. 48; Jones, p. 42-43. Therefore, Pave Tech is using the term "cat" to intentionally trade on the goodwill of the Caterpillar Marks in connection with heavy equipment.

Second, the PAVERCAT and Caterpillar products are confusingly similar. Despite the fact that Pave Tech attempted to distinguish the PAVERCAT product from a Caterpillar skid steer loader, Bob Cramer admitted during his deposition that both a skid steer loader and a PAVERCAT perform some of the same functions – back dragging and moving pavers. Cramer, p. 47. Moreover, Pave Tech admitted that Pave Tech has used and continues to use skid steer loaders instead of the PAVERCAT product for installing segmental pavers and in demonstrations. Jones, p. 75; Cramer, p. 9-18.

Third, the PAVERCAT and Caterpillar products are sold in the same market. Pave Tech attempted to distinguish Caterpillar markets by claiming that the target market for the PAVERCAT is the small, niche segmental paver market. However, as admitted by Stephen Jones, this niche market is a subset of the general construction and landscaping markets – both of which are Caterpillar target markets. Jones, p. 71-72. In addition to this admission, it is clear from Bob Cramer's testimony that Caterpillar and Pave Tech's marketing efforts overlap. Bob Cramer, Pave Tech's

Michael J. O'Loughlin  
Rebecca Jo Bishop  
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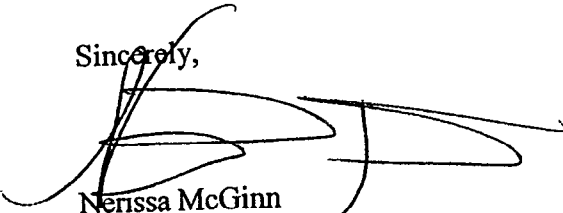
30(b)(6) witness on trade shows, admitted that Caterpillar and Pave Tech attended the same trade shows. Cramer, p. 34. The trade shows which both Caterpillar and Pave Tech attended include the following: the World of Concrete 2000 (which is the first trade show where Pave Tech first introduced the PAVERCAT); the World of Concrete 2001, the Green Industry Expo 2002, and the Green Industry Expo 2003. Cramer, p. 9-18, 23-24, 33, 39-40. Therefore, Caterpillar and Pave Tech's markets overlap.

Because the deposition testimony strongly supports Caterpillar's arguments that there is a likelihood of confusion between the marks, Caterpillar suggests settling this matter. Caterpillar has attached a proposed settlement agreement to this letter as Exhibit 1.

Caterpillar believes settling this matter before either party incurs any additional discovery expenses will be best for both parties. In addition, Caterpillar believes that settlement in this action is particularly attractive for Pave Tech since it is no longer using the PAVERCAT mark and has no plans to use the PAVERCAT mark in the future. However, Caterpillar would be willing to discuss an appropriate phase out period if necessary.

If Pave Tech does not agree to the terms of the attached settlement agreement, Caterpillar intends to aggressively proceed with the outstanding discovery issues. This would include deposing both Glenn Wroblewski and Dale Sopkowiak. We have attached notices of deposition as Exhibit 2 for both of these witnesses with tentative dates for the depositions that we can discuss in the future. Caterpillar would like to conduct these depositions in early May if Pave Tech does not agree to settle this matter by that time.

Sincerely,



Nerissa McGinn  
for Loeb & Loeb LLP

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## SETTLEMENT AGREEMENT

This Settlement Agreement ("Agreement") is made and entered into between Caterpillar Inc. ("Caterpillar"), a Delaware corporation with its principal place of business in Peoria, Illinois and Pave Tech, Inc. ("Pave Tech"), a Minnesota corporation with its principal place of business in Prior Lake, Minnesota. This Agreement is effective as of the date of the last required signature below (the "Effective Date").

WHEREAS, Caterpillar is a Delaware corporation with business operations in many areas, including the development, manufacture, distribution, marketing and sale of earthmoving and construction equipment, repair and maintenance services thereof, and the distribution through licensees and otherwise of a wide variety of licensed merchandise including casual clothing, and promotional items, such as note pads, stationary portfolios, pencils, and pens.

WHEREAS, Caterpillar owns the CATERPILLAR and CAT marks and the **CATERPILLAR** and **CAT** design marks, for a variety of goods and services, including as a trademark for heavy equipment (the "Caterpillar Marks") and owns registrations for the marks in the United States Patent and Trademark Office, including U.S. Registration Nos. 277,416, 564,272, 1,579,437, and 2,448,848.

WHEREAS, Pave Tech is a Minnesota corporation located in Prior Lake, Minnesota.

WHEREAS, in 2000, subsequent to Caterpillar's use of the Caterpillar Marks,

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Pave Tech adopted and began using the mark PAVERCAT in connection with the sale of machines and machine parts used to aid in the installation of segmental pavers.

WHEREAS, on January 28, 2000, Pave Tech filed an application to register the mark PAVERCAT for "machines and machine parts used to aid in the installation of segmental pavers." The application matured to registration on February 4, 2003.

WHEREAS, Caterpillar has objected to Pave Tech's use and petitioned to cancel Pave Tech's PAVERCAT registration (Reg. No. 2,684,138); and

WHEREAS, the parties desire the resolve and settle Caterpillar's objections and Cancellation No. 92,041,776.

NOW, THEREFORE, in consideration of the foregoing, the covenants and agreements set forth herein, and other good and valuable consideration, the receipt and sufficiency of which the parties hereby accept and acknowledge, the parties agree as follows:

1. Simultaneously with its execution of this Agreement, Pave Tech will execute the attached Surrender for Cancellation in the form attached hereto as Exhibit A and thereby irrevocably abandons its rights in and to Federal Registration No. 2,684,138 for the PAVERCAT mark together with the goodwill symbolized by and associated with the mark.

2. As of the Effective Date of this Agreement, Pave Tech shall permanently cease all use of PAVERCAT and shall not use or attempt to register any name or mark that a) is an imitation or simulation of any of Caterpillar's trademarks; b) includes the

word "CAT" or "KAT" or c) is likely to dilute the distinctiveness of any of the Caterpillar trademark or tarnish the goodwill associated with any of them.

3. Within seven (7) days after the Effective Date, Pave Tech shall supply Caterpillar's counsel all materials that bear the PAVERCAT mark for destruction and execute the affidavit attached as Exhibit B.

4. Each party shall bear its own costs and attorneys' fees incurred with respect to this action and with respect to this agreement except as described in Paragraph 12.

5. Waiver of any breach of this Agreement shall be ineffective unless in writing and signed by the Party having waived compliance and shall not be considered a waiver of any other breach.

6. This Agreement, along with its attachments, represents the entire understanding of the Parties with respect to the subjects covered by the Agreement, replaces any prior written or oral agreements, and may not be changed or modified except by a writing signed by both Parties.

7. This Agreement shall bind the Parties, their officers, directors, representatives, licensees, agents, successors, assigns, affiliates, subsidiaries, divisions, shareholders, and all parties in active concert of participation with any of them, and is effective worldwide.

8. Pave Tech shall maintain the terms of this Agreement and the circumstances leading up to and surrounding this Agreement in confidence and, except as

necessary to comply with a court order to secure legal advice, shall not disclose those terms and circumstances to others, without Caterpillar's prior, written consent.

9. The provisions of this Agreement are severable. If any provision of this Agreement is held invalid, illegal, or unenforceable, the remainder of the Agreement shall remain in full force and effect, provided the essential purposes of the Agreement are maintained.

10. The Agreement was negotiated and reviewed by each party's legal counsel and there will be no presumption for or against any party on the grounds that another party prepared the Agreement.

11. This Agreement shall be governed by and construed and enforced in accordance with the laws of the State of Illinois without regard to choice of law principles.

12. In any action to enforce this Agreement, the prevailing Party shall be entitled to recover its actual attorneys' fees and costs in addition to any other remedy to which it is entitled.

13. This Agreement may be executed in counterparts. Signatures on separate originals shall constitute and be of the same effect as signatures on the same original.

14. The undersigned warrant that they have the authority to sign this Agreement on behalf of the Party for whom he or she has signed.

**CATERPILLAR INC.**

By: \_\_\_\_\_

Date: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

**PAVE TECH, INC.**

By: \_\_\_\_\_

Date: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,684,138: PAVERCAT  
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,	)	
	)	
Petitioner,	)	
	)	Cancellation No. 41,776
v.	)	
	)	
PAVE TECH, INC.,	)	
	)	
Registrant.	)	
	)	
	)	

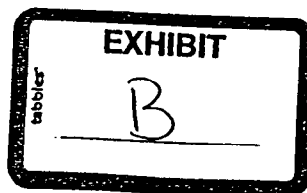
**DECLARATION OF \_\_\_\_\_**

1. My name is \_\_\_\_\_. I work for Pave Tech, Inc. ("Pave Tech") which is located in Prior Lake, Minnesota. I have personal knowledge of the facts set forth herein and can testify competently hereto.

2. Caterpillar, Inc. ("Caterpillar") and Pave Tech have agreed to resolve and settle Caterpillar's objections to Pave Tech's use of the PAVERCAT mark and Cancellation No. 41,766. Attached as Exhibit 1 is a copy of the signed Settlement Agreement between Caterpillar and Pave Tech.

3. Pave Tech has complied with Paragraph 1 of the attached Settlement Agreement by executing the Surrender of Cancellation attached as Exhibit A to the Settlement Agreement and thereby irrevocably abandoning its rights in and to Federal Registration No. 2,684,138, for the PAVERCAT Mark together with the goodwill symbolized by and associated with the mark.

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4. Pave Tech has complied with Paragraph 2 of the attached Settlement Agreement by permanently ceasing all use of the PAVERCAT mark.

5. Pave Tech has complied with Paragraph 3 of the attached Settlement Agreement by supplying to Caterpillar's counsel all materials that bear the PAVERCAT mark for destruction and by sending Caterpillar's counsel a copy of this executed affidavit.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on the \_\_\_\_th of April, 2004.

---



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,684,138: PAVERCAT  
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,	)	
	)	
Petitioner,	)	
	)	Cancellation No. 41,776
v.	)	
	)	
PAVE TECH, INC.,	)	
	)	
Registrant.	)	

**NOTICE OF DEPOSITION**

TO: Michael J. O'Loughlin  
Michael J. O'Loughlin & Associates, P.A.  
1012 Grain Exchange Building  
400 South 4<sup>th</sup> Street  
Minneapolis, MN 55415

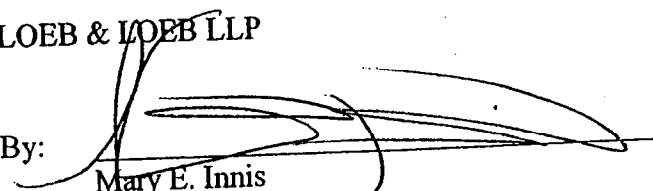
On Wednesday, May 12, 2004, beginning at 9:30 am, Petitioner, Caterpillar Inc., will depose the person identified below before a court reporter or other person qualified to administer oaths. The depositions will take place at Brown and James Reporting, 312 E. Wisconsin Avenue, Suite 608, Milwaukee, WI 53202 and continue until completed. The deposition shall be recorded by means chosen by Petitioner. The deponent shall be the following:

1. Glen Wrobleski

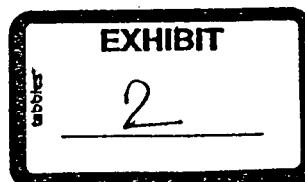
Dated: April 28, 2004

LOEB & LOEB LLP

By:

  
Mary E. Innis  
Nerissa Coyle McGinn  
200 South Wacker Drive, Suite 3100  
Chicago, Illinois 60606  
Telephone: (312) 674-4780  
Facsimile: (312) 674-4779

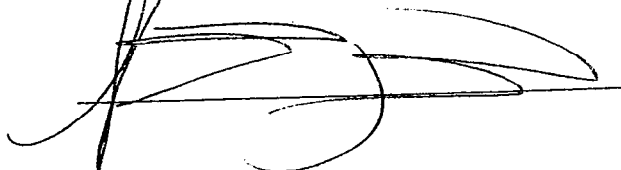
*Attorneys for Petitioner*



**CERTIFICATE OF SERVICE**

The undersigned attorney hereby certifies that true and correct copy of the foregoing  
**AMENDED NOTICE OF DEPOSITION** was served via facsimile and U.S. Mail on April 28,  
2004 to the following counsel of record:

Michael J. O'Loughlin  
Michael J. O'Loughlin & Associates, P.A.  
1012 Grain Exchange Building  
400 South 4<sup>th</sup> Street  
Minneapolis, MN 55415

A handwritten signature in black ink, appearing to be "Michael J. O'Loughlin", written over a horizontal line.

In the Matter of Registration No. 2,684,138: PAVERCAT  
Registered on the Principal Register on February 4, 2003, in International Class 7

**Registrant.**

Cancellation No. 41,776

TO: Michael J. O'Loughlin  
Michael J. O'Loughlin & Associates, P.A.  
1012 Grain Exchange Building  
400 South 4<sup>th</sup> Street  
Minneapolis, MN 55415

On Friday, May 14, 2004, beginning at 9:30 am, Petitioner, Caterpillar Inc., will depose the person identified below before a court reporter or other person qualified to administer oaths. The depositions will take place at Lindquist & Vennum P.L.L.P., 4200 IDS Center, 80 South 8<sup>th</sup> Street, Minneapolis, MN 55402 and continue until completed. The deposition shall be recorded by means chosen by Petitioner. The deponent shall be the following:

1. Dale Sapkowiak

Dated: April 28, 2004

~~LOEB & LOEB~~ LLP

By:

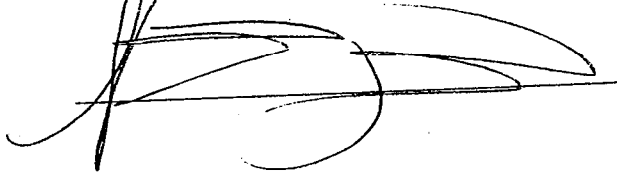
Mary E. Innis  
Nerissa Coyle McGinn  
200 South Wacker Drive, Suite 3100  
Chicago, Illinois 60606  
Telephone: (312) 674-4780  
Facsimile: (312) 674-4779

Attorneys for Petitioner

**CERTIFICATE OF SERVICE**

The undersigned attorney hereby certifies that true and correct copy of the foregoing  
**AMENDED NOTICE OF DEPOSITION** was served via facsimile and U.S. Mail on April 28,  
2004 to the following counsel of record:

Michael J. O'Loughlin  
Michael J. O'Loughlin & Associates, P.A.  
1012 Grain Exchange Building  
400 South 4<sup>th</sup> Street  
Minneapolis, MN 55415

A handwritten signature in black ink, appearing to be "Michael J. O'Loughlin", written over a horizontal line.

**B**

### DECLARATION OF MARY E. INNIS

2. At the February 23 and 24<sup>th</sup> depositions of Steven Jones and Bob Cramer, I told Pave Tech's attorney that Caterpillar intended to send Pave Tech a settlement proposal after receiving and reviewing the deposition transcripts. Moreover, Pave Tech's counsel indicated that he did not want to discuss settlement until had had a chance to review the deposition transcripts. Caterpillar did not receive the deposition transcripts until well into March.

3. I also told Pave Tech's counsel at the February 23 and 24<sup>th</sup> depositions that Caterpillar intended to take the depositions of Glenn Wrobeleski and Dale Sopkowiak. Both of these witnesses were identified during the depositions as people who had direct contact via telephone at trade shows with consumers who possibly could be confused between the Caterpillar Marks and the PAVERCAT mark.

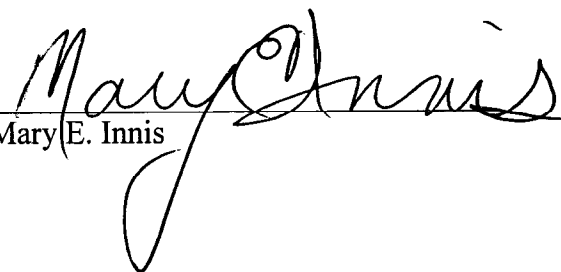
4. On April 21, 2004 – two weeks before the end of discovery and a year after discovery opened– I received Pave Tech's first written notice that it intended to take any depositions. On that day, I received the deposition notices for Gene Bolmarcich in Illinois, for Terry Sharpe in Minnesota, and a 30(b)(6) witness.

5. Because of the breadth of the twenty-eight 30(b)(6) deposition topics, multiple deponents would have had to identify multiple witnesses to cover all of these topics. It is very possible that not all of these witnesses would be located in Peoria. In fact, one of the witnesses may be located in Texas.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on the 1st day of June, 2004.

Date: June 1, 2004

  
Mary E. Innis

C

-----Original Message-----

From: Mary Innis  
Sent: Thursday, April 22, 2004 3:18 PM  
To: 'rbishop@alteralaw.com'  
Subject: RE: Caterpellar v. Pave Tech Cancellation (Our Ref. 01000.0319-US-TA)

Ms. Bishop,  
Please be advised that both Ms. McGinn and I are out of the office. I do know, however, that we will need to reschedule the depositions as both Nerissa and I are out of the office May 1-7. In addition, I believe that we will need to agree to extend the discovery period to schedule the depositions and further depositions on our end. We also might want to discuss some settlement options. I will call you today if I am able or tomorrow to discuss further.

Regards,  
Mary Innis

-----Original Message-----

From: Rebecca Bishop [mailto:rbishop@alteralaw.com]  
Sent: Wednesday, April 21, 2004 1:38 PM  
To: Mary Innis; Nerissa McGinn  
Cc: Rebecca Bishop; minnlaw@mn.rr.com  
Subject: Caterpellar v. Pave Tech Cancellation (Our Ref. 01000.0319-US-TA)

Ms. Innis and Ms. Coyle McGinn,

Good afternoon. Please find attached and served on you three Notices of Deposition by Pave Tech, Inc. in connection with the above-identified cancellation matter. I am also sending a copy via U.S. mail today. As stated in the notices, Pave Tech is open to discussing alterations in the deposition times and places, but did attempt to notice the deponents in the jurisdiction in which, to the best of our knowledge, they reside.

I intend to call one of you this afternoon to introduce myself and to discuss the notices further. If you have any questions before then, please do not hesitate to contact me at the information below.

Very truly yours,  
Rebecca Bishop



ALTERA LAW GROUP

6500 City West Parkway

Suite 100

Eden Prairie, MN 55344-7704

952.253.4100 (direct)

952.912.0574 (fax)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,684,138: PAVERCAT  
Registered on the Principal Register on February 4, 2003, in International Class 7

CATERPILLAR INC.,	)	
	)	
Petitioner,	)	
v.	)	Cancellation No. 41,776
	)	
PAVE TECH, INC.,	)	
	)	
Registrant.	)	

**DECLARATION OF NERISSA COYLE MCGINN  
IN SUPPORT OF CATERPILLAR'S  
MOTION FOR EXTENSION**

1. I am an attorney with Loeb & Loeb LLP, 200 South Wacker, Suite 3100, Chicago, Illinois 60606, counsel of Petitioner, Caterpillar Inc. ("Caterpillar"). I am one of the lawyers primarily responsible for the above captioned matter on Caterpillar's behalf. In such capacity, I submit this affidavit in support of Caterpillar's Motion for Extension of the Discovery and Testimony Periods. I have personal knowledge of the facts set forth herein and can testify competently hereto.

2. On April 21, 2004, Pave Tech served three notices of depositions on Caterpillar for the last three days before discovery closes on May 5, 2004. The depositions noticed were for the following persons: Terry G. Sharp on May 3, 2004 in Eden Prairie, Minnesota; Gene Bolmarcich on May 4, 2004 in Peoria, Illinois, and Caterpillar's 30(b)(6) witnesses on May 5, 2004 in Peoria, Illinois. Exhibit A, Pave Tech Notices of Depositions. In the e-mail accompanying the notices of depositions, Pave Tech's counsel indicated that Pave Tech was open to "alterations in the deposition times and places."

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3. On April 22<sup>nd</sup>, Caterpillar's counsel responded to Pave Tech's e-mail stating that both of Caterpillar's attorneys would be out of the office from May 1<sup>st</sup> to May 7<sup>th</sup> and that the depositions would have to be rescheduled. In that same e-mail, Caterpillar's counsel stated the parties "would need to agree to extend the discovery period to schedule the depositions and further depositions on our end."

4. On April 27, 2004, Caterpillar's counsel spoke with Pave Tech's attorney, Rebecca Bishop, regarding an extension of the discovery schedule, the additional depositions that Caterpillar intended to take, and a potential settlement. During that conversation, Caterpillar's counsel requested a 60 day extension of the discovery deadline for both of the parties to take the depositions they had requested. Ms. Bishop indicated that Pave Tech would be willing to agree to a 30 day extension of discovery but that she would have to ask her client before she could agree to a 60 day extension of discovery.

5. On April 28, 2004, Caterpillar sent Pave Tech a letter with a settlement proposal. In addition to the settlement proposal, the letter also attached two notices of depositions for Dale Sapkowiak on May 14, 2004 and Glen Wroblewski on May 12, 2004. These were the two depositions Caterpillar had referred to in its April 22, 2003 e-mail.

6. On April 29, 2004, Pave Tech's attorney reneged on its previous agreements to extend the discovery period and to reschedule the May 3-5 depositions. Pave Tech's counsel suddenly insisted on taking the depositions on May 3-5 unless Caterpillar would agree to a "unilateral" extension of time. The terms of this "unilateral" extension of time would allow Pave Tech to take its three depositions after the close of

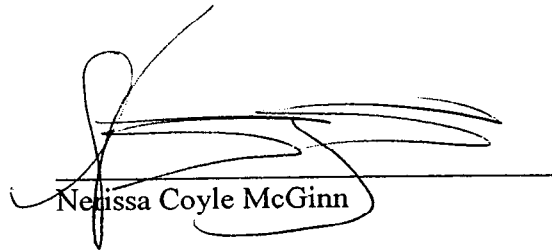
discovery, but would preclude Caterpillar from taking the two depositions that it had noticed up during the discovery period.

7. Caterpillar argued that this proposal directly violated the oral agreement between the parties discussed on April 27<sup>th</sup>. Not surprisingly, Pave Tech's attorney denied that she had agreed to an extension of time claiming that she had stated that "I do not have a problem with the 30 day extension", not that her client does not have problem with the 30 day extension. Pave Tech did not deny that it had previously stated that it would be willing to reschedule with depositions.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on the 30<sup>th</sup> day of April, 2004.

Date: April 30, 2004



Nedissa Coyle McGinn